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| APPLICATION NO.                                                                          | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|------------------------------------------------------------------------------------------|-------------|----------------------|---------------------|------------------|
| 10/652,147                                                                               | 08/29/2003  | Greg Hahn            | 60,298-517;ST 167   | 1158             |
| 26096                                                                                    | 7590        | 07/22/2004           |                     |                  |
| CARLSON, GASKEY & OLDS, P.C.<br>400 WEST MAPLE ROAD<br>SUITE 350<br>BIRMINGHAM, MI 48009 |             |                      |                     |                  |
| EXAMINER                                                                                 |             |                      |                     |                  |
| RODRIGUEZ, WILLIAM H                                                                     |             |                      |                     |                  |
| ART UNIT                                                                                 |             | PAPER NUMBER         |                     |                  |
| 3746                                                                                     |             |                      |                     |                  |

DATE MAILED: 07/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                         |                                    |  |
|------------------------------|-----------------------------------------|------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/652,147    | <b>Applicant(s)</b><br>HAHN ET AL. |  |
|                              | <b>Examiner</b><br>William H. Rodriguez | <b>Art Unit</b><br>3746            |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                                              |                                                                                        |
|----------------------------------------------------------------------------------------------------------------------------------------------|----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                                             | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/29/03</u> . | 6) <input type="checkbox"/> Other: ____                                                |

## **DETAILED ACTION**

### ***Specification***

1. The specification is objected to because on pages 2 and 4 the patent application number and filing date for the invention titled "Compressor Diagnostic System" is not provided. Correction is required.

The terminology "high volt" and "low volt" is ambiguous. It would appear that Applicant is referring to the potential difference expressed in volts, in which case --high voltage-- or --low voltage-- would be the appropriate art terminology. Appropriate correction is required.

### ***Oath/Declaration***

2. It does not identify the city and state or foreign country of residence of James W. Bush. Appropriate correction is required.

### ***Claim Objections***

3. Claim 3 is objected to because of the following informalities: Claim 3 does not end with a period. Appropriate correction is required.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

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F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-8 and 10-11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of **U.S. Patent No. 6,558,126**. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons:

Claim 1 of the instant application is merely broader than claim 1 of the patent. Claim 1 of the instant application recites the following elements: *a sealed compressor shell, a compressor pump unit, an electric motor, a low voltage device, an inlet, a high voltage electric power supply, a system for converting high voltage to low voltage*. While, claim 1 of the patent recites the following elements: *a sealed compressor shell, a compressor pump unit, an electric motor, a low voltage microprocessor diagnostic control "a low voltage device", an inlet, a high voltage electric power supply, a system for converting high voltage to low voltage*. Thus, the elements recited by claim 1 of the instant application are contained within claim 1 of the patent. Therefore, claim 1 of the patent "anticipates" the broader claim 1 of the instant application.

Claim 10 of the instant application is merely broader than claim 8 of the patent. Claim 10 of the instant application recites the following elements: *a sealed compressor shell, a compressor*

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*pump unit, an electric motor, a diagnostic control device, a conversion circuit, an inlet, a high voltage electric power supply.* While, claim 8 of the patent recites the following elements: *a sealed compressor shell, a compressor pump unit, an electric motor, a diagnostic microprocessor control device, a conversion circuit, an inlet, a high voltage electric power supply.* Thus, the elements recited by claim 10 of the instant application are contained within claim 8 of the patent. Therefore, claim 8 of the patent “anticipates” the broader claim 10 of the instant application.

Note: The same analysis applies to dependent claim 2-8 and 11 of the instant application. Compare claims 2-8 and 11 of the instant application with claims 2-7 and 9 of the patent.

6. Claim 9 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of **U.S. Patent No. 6,641,368**. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons:

Claim 9 of the instant application is merely broader than claim 1 of the patent. Claim 9 of the instant application recites the following elements: *a sealed compressor shell, a low voltage device, converting high voltage to low voltage.* While, claim 1 of the patent recites the following elements: *a sealed compressor shell, a low voltage microprocessor, converting high voltage to low voltage.* Thus, the elements recited by claim 9 of the instant application are contained within claim 1 of the patent. Therefore, claim 1 of the patent “anticipates” the broader claim 9 of the instant application.

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***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-6, 9 and 10-11 are rejected under 35 U.S.C. 102(b) as being anticipated by **Mizutani et al. (US- 5,509,786)**.

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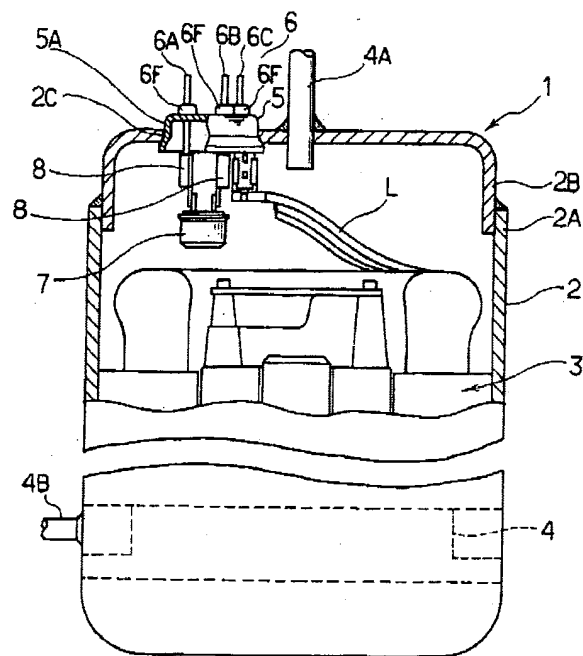


FIG. 1

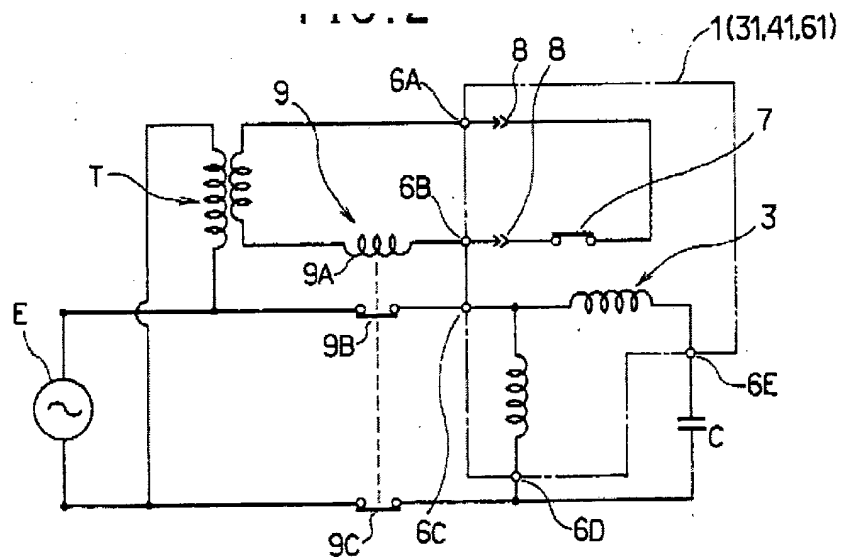


FIG. 3

**Mizutani** teaches a sealed scroll compressor shell housing 1 a scroll compressor, an electric motor 3 for driving said scroll compressor, and a low voltage device 7 "diagnostic control" for

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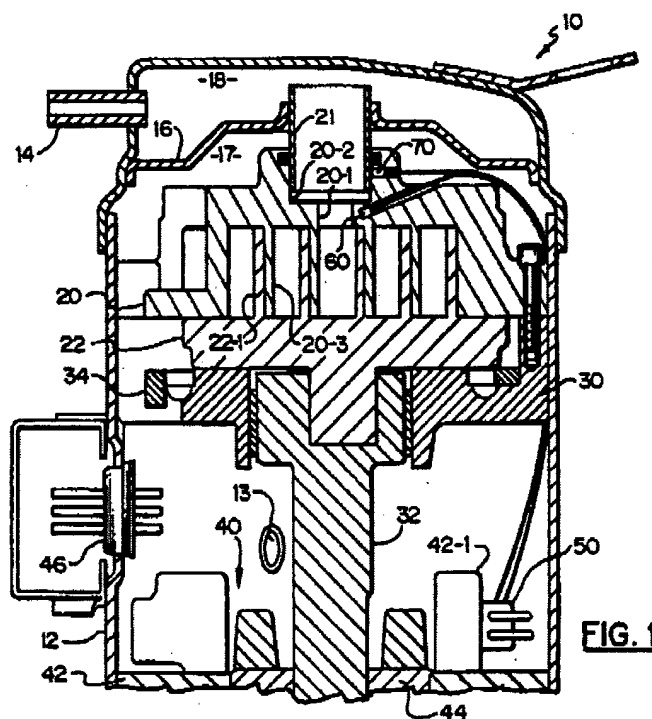
monitoring the compressor performance; an inlet opening 2c in said compressor shell for receiving an incoming high volt electric power supply for powering said electric motor 3; and a system within said sealed compressor shell for converting said incoming high voltage electric power to a low volt electric power; and feeding low volt electric power to said low voltage device, a transformer T and a power tap (inherent in a system for stepping down a high voltage) . According to **Mizutani**, "The hermetic refrigeration compressor may further include first control means for controlling the motor, means for supplying a control voltage to a circuit including a thermal protector, the control voltage being lower than a voltage supplied to the motor". See column 3 lines 15-25 and **Figures 1-3** and **7-10** of Mizutani. The diagnostic control 7 interrupts power to the motor 3 if the refrigerant exceeds an operating temperature of the system.

Since **Mizutani** has the same structure as claimed, it is inherent that **Mizutani's** device would be able to perform the recited method steps.

9. Claims 1-5, 7, 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by **D'Entremont et al (US- 5,200,872)**.



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**D'Entremont** teaches a sealed scroll compressor shell housing 12 a scroll compressor 10, an electric motor for driving said scroll compressor, and a low voltage device 60 "a sensor" for monitoring the compressor performance; an inlet opening in said compressor shell for receiving an incoming high volt electric power supply for powering said electric motor; and a system within said sealed compressor shell for converting said incoming high voltage electric power to a low volt electric power; and feeding low volt electric power to said low voltage device, a valve (not shown but mentioned, column 2 lines 24-36), a transformer and a power tap (inherent in a system for stepping down a high voltage). See column 3 lines 5-14, 20-35 and **Figure 1** of D'Entremont.

Since **D'Entremont** has the same structure as claimed, it is inherent that **D'Entremont's** device would be able to perform the recited method steps.

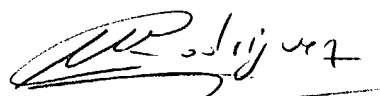
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***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Rodriguez whose telephone number is 703-605-1140. The examiner can normally be reached on Monday-Friday 7:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine R Yu can be reached on 703-308-2675. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



William H. Rodriguez  
Examiner  
Art Unit 3746